

REMARKS

I. Preliminary Matters

Claims 37-40 were withdrawn over the phone following a restriction requirement, and claim 41 is added, hence, claims 1-36 presently are pending. Applicants hereby amend claims 1, 17 and 27 to improve clarity. Support for the amendments may be found at least at page 3, lines 6 – 11 and page 7, lines 8-12, of the present application as filed. Applicants submit that the amendments do not recite new matter.

II. Double Patenting

Claims 1, 15-17, 23, and 27-36 were rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 41-51, 57-58, 62, and 73-75 of U.S.S.N. 11/780,930. Applicants respectfully request that the rejection be held in abeyance pending resolution of the patentability of the claims with regard to all other matters.

III. Rejections Under 35 U.S.C. § 103

A. Claims 1-22 and 24-26

Claims 1-22 and 24-26 stand rejected under 35 U.S.C. § 103 as allegedly rendered obvious by Melchione et al. (US Patent No. 5,930,764) in view of Walker et al. (US Pub. No. 2008/0052225). Applicants respectfully traverses the rejection of these claims as amended.

Melchione describes a sales system that identifies sale leads for marketing campaigns.¹ The sales system includes an “electronic sales and service support system” for opening a bank account for new or old customers.² Critically, after completing the process and opening the new account, the system distributes a new bank card to the account holder, if the account holder so

¹ Melchione, Abstract.

² Melchione, 44:10-20..

elects.³ The claimed invention, instead of opening a bank account and creating a bank card linked to a live bank account, creates a *dead bank card associated with an inactive bank account*. By sending a bank card linked to a live bank account, the sales system in Melchione must receive permission to open the bank account from the account holder, and then account holder must wait to receive the bank card, inconveniencing the card holder and providing a disincentive to opening a new bank account. It is not feasible, and maybe even illegal, to open a bank account for a consumer and then pitch the consumer to accept the new account. The claimed invention, however, overcomes this problem as well the disincentives in prior systems by creating an *inactive bank account* associated with a *dead bank card*. A consumer need only accept the account and card, and both may be activated, eliminating at least some of the inconvenience and disincentives of prior systems.

The Office Action recognizes at least some of Melchione's deficiencies in this regard,⁴ and instead cites Walker as allegedly teaching the claimed dead bank card. However, Walker actually describes a dead credit card, not a dead bank card, let alone a dead bank card associated with an inactive bank account. In the financial world, credit is very different than checking/savings accounts. A credit card are linked to a form of an open line of credit, which is essentially an on demand extremely short-term loan to the holder of the credit card.⁵ Bank accounts are funds entrusted to a bank from which an account holder can make withdrawals.⁶ As explained in the background of the instant application, consumers are generally receptive to

³ Melchoine, 55:42-43.

⁴ Office Action dated October 19, 2009, at p. 5.

⁵ Exhibit 1 (Rohner et al., Truth in Lending, 485-493 (American Bar Association, 2000)).

⁶ Exhibit 2 (The Ne Palgrave Dictionary of Money and finance, 348-349 (The Stockton Press, 1992, Newman, Peter; Milgate, Murray; Eatwell, John eds.)

offers to open a new credit card and a line of credit, but less receptive to offers to open a new bank account (which might require moving funds from another account).

The differences in treatment of credit cards and bank cards are illustrated in the instant application. In one exemplary embodiment, credit card applications are used to identify qualified applicants that may be receptive to opening a new bank account.⁷ Applicants then receive a live credit card *and* a dead bank card.⁸ This is because credit and fund accounts represent entirely different relationships between a bank and a borrower/account holder.

For these reasons described above, independent claim 1 would not have been rendered obvious by Melchione in view of Walker, because alone or in combination the references do not teach or suggest all of the features and limitations of the claim. Accordingly, Applicants request that the Examiner withdraw the rejection of claim 1 and claims 2-16 *at least* by virtue of their dependency from an allowable base claim.

Regarding independent claim 17, for the reasons stated above Melchione in view of Walker do not teach or suggest, “distributing a live credit card and a dead bank card associated with an inactive bank account to the customer if the application is approved and the customer is not an existing bank account holder.” Applicants request that the Examiner withdraw the rejection of claim 17, and dependent claims 18-22 and 24-26.

⁷ Application as filed, p. 10, lines 1-5.

⁸ Application as filed, p. 10, lines 8-9.

B. Claims 27-32

Claims 27-32 stand rejected as allegedly rendered obvious by Jones et al. (US Pub. No. 2004/0117300) in view of Walker.⁹ Applicants respectfully traverse this rejection of the claims as amended.

The combination of Jones and Walker suffers from *at least* a similar deficiency as the combination of Melchione and Walker: neither reference teaches or suggests “distributing a live credit card and a dead bank card *associated with an inactive bank account* to the customer if the application is approved and the customer is not an existing bank account holder,” as recited in claim 27. Jones is related to a payment card processing system that allows a payment card to be used on two different payment networks.¹⁰ Jones describes utilizing a “dual card,” which is, essentially, a single card that can be used a private label card and a bankcard, thus reducing the number of card a consumer has to carry.¹¹ Not surprisingly, part of the process is sending a user the “dual card.”¹² When the dual card is distributed, it is associated with a live credit account, an a live bank account as evidenced by the fact that the user applies for opts into the dual card.¹³ Thus, as with Melchoine, the system in Jones must receive permission from a consumer before sending the card. As explained above, the claimed invention does not suffer from this limitation.

The Office Action recognizes the deficiencies of Jones, and instead cites Walker. However, as described above, Walker does not teach or suggest a *dead bank card associated with an inactive bank account*. Thus, Applicants respectfully submit that claim 27 would not

⁹ The Office Action indicates that the claims are rejected under 35 U.S.C. § 102(e), however since the rejection is presented in the form of a combination of two reference, Applicants assume that the Examiner meant that the references qualify as § 102(e) prior art, but the basis of the rejection is § 103(a).

¹⁰ Jones, par. [0002].

¹¹ Jones, par. [0008], [0022].

¹² Jones, Fig. 5A.

¹³ Jones, par. [0027]

have been rendered obvious by Jones in view of Walker because the references, alone or in combination, do not teach or suggest each and every limitation of the claims. Accordingly, Applicants request that the Examiner withdraw the rejection of claim 27, and claims 28-32 *at least* in view of their dependency from an allowable base claim.

C. Claim 23

Claim 23 stands rejected as allegedly rendered obvious by Melchione in view of Walker and further in view of Strock et al. (US Pub. No. 2004/0122736).¹⁴ Applicants respectfully traverse this rejection.

As Strock relates to a system and method for providing promotional rewards, it clearly does not compensate for the deficiencies of Melchione and Walker with regard to independent claim 1. Accordingly, claim 23 is at least patentable by virtue of its dependency from claim 1, and Applicants respectfully request that the Examiner withdraw the rejection of this claim.

D. Claims 33-36

Claims 33 – 36 stand rejected as allegedly rendered obvious by Jones in view of Walker and further in view of Strock.¹⁵ Applicants respectfully traverse this rejection.

For the reasons noted above, Jones, Walker and Strock do not teach or suggest all of the limitations of claim 27, thus, claims 33-36 are *at least* patentable by virtue of their dependency from claim 27. Accordingly, Applicants respectfully request that the Examiner withdraw the rejection of these claims.

¹⁴ Page 13 of the Office Action indicates that claim 23 is rejected over Melchione in view of Strock, however, claim 13 is a dependent claim considered to include all of the limitations of claim 1, thus, any obviousness combination must include Walker.

¹⁵ Page 15 of the Office Action indicates that claim 33-36 is rejected over Jones in view of Strock, however, claim 33-36 are dependent claim considered to include all of the limitations of claim 27, thus, any obviousness combination must include Walker.

III. CONCLUSION

In view of the foregoing, it is respectfully submitted that the present application is in condition for allowance, and an early indication of the same is courteously solicited. The Examiner is respectfully requested to contact the undersigned by telephone at the below listed telephone number, in order to expedite resolution of any issues and to expedite passage of the present application to issue, if any comments, questions, or suggestions arise in connection with the present application.

Please charge any shortage in fees due in connection with the filing of this paper to Deposit Account No. 07-1700, and please credit any excess fees to the same deposit account.

Should the Examiner believe anything further is desirable in order to place the application in even better condition for allowance, the Examiner is invited to contact Applicant's undersigned representative at the telephone number listed below.

Dated: December 31, 2009

Respectfully submitted,

Electronic signature: /Andrew J. Baca/
Andrew J. Baca

Registration No.: 60,887
GOODWIN PROCTER LLP
53 State Street
Boston, MA 02109
(617) 570-8261
Attorney for Applicant